



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Attorney Docket No. 016778/0422

Applicant: Takashi NITAKI

Title: ACCESS RIGHT MANAGING SYSTEM, PORTABLE TERMINAL,  
GATEWAY AND CONTENTS SERVER

Serial No.: 09/740,981

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Art Unit: 2131

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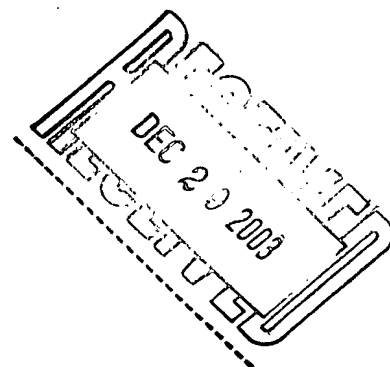
**INFORMATION DISCLOSURE STATEMENT  
UNDER 37 CFR §1.56 and 37 CFR §1.97**

Commissioner for Patents  
P.O. Box 1450  
Alexandria, Virginia 22313-1450

Sir:

Submitted herewith on Form PTO-SB/08 is a listing of documents known to Applicant in order to comply with Applicant's duty of disclosure pursuant to 37 CFR 1.56. A copy of each listed document is being submitted to comply with the provisions of 37 CFR 1.97 and 1.98.

The submission of any document herewith, which is not a statutory bar, is not intended as an admission that such document constitutes prior art against the claims of the present application or that such document is considered material to patentability as defined in 37 CFR §1.56(b). Applicant does not waive any rights to take any action which would be appropriate to antedate or otherwise remove as a competent reference any document which is determined to be a prima facie prior art reference against the claims of the present application.



**TIMING OF THE DISCLOSURE**

The instant Information Disclosure Statement is believed to be filed in accordance with 37 C.F.R. 1.97(b), prior to the mailing date of a first Office Action on the merits (first scenario). If that is not the case, such as in a second scenario in which a first Office Action on the merits has been mailed before the filing of the instant Information Disclosure Statement, then either a certification or fee is required, and a certification is provided below. If neither of the first or second scenarios is the case, such as if a final Office Action or a notice of allowance has been mailed by the PTO (third scenario), then both a certification and fee are required, and in that case a certification is provided below and also the PTO is authorized to obtain the necessary fee to have the instant IDS considered, from Foley & Lardner Deposit Account #19-0741.

**CERTIFICATION**

The undersigned hereby certifies in accordance with 37 C.F.R. §1.97(e)(1) that items of information A5 and A6 listed on the Form PTO SB/08 submitted with this Information Disclosure Statement were first cited in a communication from a foreign patent office in a counterpart foreign application not more than three (3) months prior to the filing of this Statement. Items of information A1 and A3 respectively correspond to a U.S. patent and a PCT patent application that are counterparts to item of information A6, and items of information A2 and A4 respectively correspond to a U.S. patent and a Japanese laid open patent application (with English language abstract submitted) that are counterparts to item of information A5.

**RELEVANCE OF EACH DOCUMENT**

A translation of a portion of a Chinese Office Action that issued October 24, 2003 with respect to a counterpart Chinese patent application is provided below.

"Detailed Office Action

The application relates to access right managing system,

portable terminal, gateway and contents server. The opinion of examining is as following.

1. Claims 1 and 2, 9-12, 14-17 do not comply with article 31(1) of the Patent Law.

The following is a quotation of article 31(1) of the Patent Law:

**An application for a patent for invention or utility model shall be limited to one invention or utility model. Two or more inventions or utility models belonging to a single general inventive concept may be filed as one application.**

Claims 1 and 2 request to protect an access right managing system having a portable terminal, a gateway and a content server. Claims 9 and 10 request to protect a portable terminal. Claims 11 and 12 request to protect a gateway. Claims 14 and 15 request to protect a content server. Claims 16 and 17 request to protect an access right managing system. It is clear that claims 1, 2, 16 and 17 respectively have unity with claims 9 and 10 or 11 and 12 or 14 and 15. And claims 9 and 10, claims 11 and 12, claims 14 and 15 do not have unity. They do not belong to a single general inventive concept, and there is no technical connection between claims 9 and 10, claims 11 and 12, claims 14 and 15, and there is no identical or corresponding special technical feature between claims 9 and 10, claims 11 and 12, claims 14 and 15. The applicant can choose one of a group claim, and file a divisional applications for the remaining claims after the group claim are issued.

2. Claims 1, 2, 14 and 15 do not comply with Rule 21 (2) of the Implementing Regulations of the Patent Law.

The following is a quotation of provisions of Rule 21 (2) of the Implementing Regulations of the Patent Law:

**The independent claim shall outline the technical solution of an invention or utility model and state the essential technical features necessary for the solution of its technical problem.**

Claims 1 and 2 request to protect an access right managing system having a portable terminal, a gateway and a content server. It is understood for a person skilled in the art from specification that following means are essential technical features necessary for the solution of its technical problem:

Gateway for converting the information received from contents server;

Receiving unit of contents server for receiving information.

Therefore claim 1 and 2 do not comply with Rule 21 (2) of the Implementing Regulations of the Patent Law.

Claims 14 and 15 request to protect a content server. It is understood for a person skilled in the art from specification that following means are essential technical features necessary for the solution of its technical problem:

Receiving unit of contents server for receiving information.

Therefore claim 14 and 15 do not comply with Rule 21 (2) of the Implementing Regulations of the Patent Law.

3. Claims 1, 9, 11, 15-17 do not comply with articles 26 (4) of the Patent Law.

The following is a quotation of articles 26 (4) of the Patent Law.

**The claims shall be supported by the description and shall state the extent of the patent protection ask for.**

Claim 1 request to protect an access right managing system having a portable terminal, a gateway and a content server. It is understood for a person skilled in the art from specification that firstly the portable terminal transmits request for use, then transmits the ID/PW after receiving ID, finally the portable terminal obtain the required data. The gateway detects whether the request for use is first access request. If so, the gateway assigns the ID/PW. If not, the gateway authenticates the request for use. It is clear that claim 1 outlines a broad scope of protection. Therefore claim 1 is not supported by the specification.

Claim 9 requests to protect a portable terminal. It is understood for a person skilled in the art from specification that firstly the portable terminal transmits request for use, then transmits the ID/PW after receiving ID, finally the portable terminal obtain the required data. It is clear that claim 9 outlines a broad scope of protection. Therefore claim 9 is not supported by the specification.

Claim 11 request to protect a gateway. It is understood for a person skilled in the art from specification that the gateway detects whether the request for use is first access request. If so, the gateway assigns the ID/PW. If not, the gateway authenticates

the request for use. It is clear that claim 11 outlines a broad scope of protection. Therefore claim 11 is not supported by the specification.

The feature of claim 15 "when predetermined authentication information is once returned and then authenticated for the acquisition request" can not be derived or outlined from specification. Therefore claim 15 is not supported by the specification.

Claims 16 and 17 request to protect an access right managing system respectively. However the claims 16 and 17 outline a broad scope of protection for the portable terminal, the gateway and content server. Therefore claims 16 and 17 are not supported by the specification.

4. Claims 2, 9, 10, 12, 15-17 do not comply with Rule 20 (1) of the Implementing Regulations of the Patent Law.

The following is a quotation of provisions of Rule 20 (1) of the Implementing Regulations of the Patent Law:

**The claims shall define clearly and concisely the matter for which protection is sought in terms of the technical features of the invention or utility model.**

The technical schemes of claims 2, 10, 12, 15 and 17 are special conception of claims 1, 9, 11, 14 and 15. It causes a repeat between claims and claims are not concise. The applicant should rewrite the claims 2, 10, 12, 15 and 17 as dependent claims of claims 1, 9, 11, 14 and 15 respectively.

The sentence "information such as characters" is not clear in the claim 1 and makes the scope of claim 1 unclear. Claims 2, 9, 10 16 and 17 have the same defects as claim 1. It does not comply with Rule 20 (1) of the Implementing Regulations of the Patent Law.

It is not clear that the feature "use request transmitting means" is first or second use request transmitting means in the claim 2.

5. Claims 9 and 14 do not possess inventive step.

The following is a quotation of article 22 (3) of the Patent Law:

**Inventiveness means that, as compared with the technology existing before the date of filing, the invention has prominent substantive features and represents a notable progress and that the utility model has substantive feature and represents progress.**

Claim 9 requests to protect a portable terminal. However reference 1 (CN 1209712A) discloses a mobile terminal and communication system between network, in which disclosing following feature:

Mobile terminal transmitting ID to the network in a predetermined effective period;

If the time is effective, the network returns an answer message to the mobile terminal.

It is obvious for a person skilled in the art, there are transmitting means and receiving means in the mobile terminal. The difference between claim 9 and reference 1 is "display means". However the feature is well known technology in the field. Therefore it is obvious for a person skilled in the art to have the technical scheme of claim 9 by combination of reference 1 and well known technology.

Claim 14 requests to protect a content server. However reference 2 (CN 1226367 A) discloses a system for preventing fraudulence calling in the radio remote communication network, in which disclosing following features:

Location register containing a database having a user information, database outputting information related to the activation performance only in the allowing time.

It is understood for a person skilled in the art that database equals to the content data storing means of claim 14, and also it can be outlined that there are receiving information means and transmitting information means in the register. The difference between claim 14 and reference 2 is that a function of content server is implemented by the register. However it is obvious for a person skilled in the art that there is the same function whichever content server or register in the system. And also it is common technology to use content server and register in the system. Therefore it is obvious for a person skilled in the art to have the technical scheme of claim 14 by combination of reference 2 and well known technology.

Based on the above reasons, this application shall not be issued according to the version of present. The applicant should amend the claims according to the above examining opinions. The application will be issued if applicant can overcome the defects; otherwise, the application will be rejected.

It is noted that the amendment shall not go beyond the scope of the specification according to the Article 33 of the Chinese Patent Law."

Applicant's statements regarding the Chinese Office Action are based on a partial translation that Applicant's representative obtained. These statements should in no way be considered as an agreement by Applicant with, or an admission of, what is asserted in the Chinese Office Action.

Applicant respectfully request that the listed documents be considered by the Examiner and formally be made of record in the present application and that an initialed copy of Form PTO/SB/08 be returned in accordance with MPEP §609.

Respectfully submitted,

December 23, 2003  
Date

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